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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,662	09/30/2003	Truc Nguyen	66329/00008	5004
23380 7590 10/28/2008 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414				
EXAMINER HANG, VU B				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
10/28/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@tuckerellis.com  
christopher.luoma@tuckerellis.com

### Office Action Summary

**Application No.**

10/674,662

**Applicant(s)**

NGUYEN ET AL.

**Examiner**

Vu B. Hang

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7 and 9-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-7 and 9-11 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

- This office action is responsive to the communication filed on 07/15/2008.
- The amendments received on 07/15/2008 have been entered and made of record.
- Claims 1, 3-7 and 9-11 are pending in the application.

#### ***Response to Arguments***

1. Applicant's arguments filed on 07/15/2008, with respect to the cited prior art Hansen et al. (US Patent 6,407,820 B1) and Bhogal et al. (US Patent 7,088,462), have been fully considered but they are not persuasive. The applicant argues that the cited prior art Hansen, does not teach a feature wherein the printer finishing options are automatically intercepted when set via a printer driver and wherein the printer finishing options can be saved and recalled for later use. The examiner disagrees for the following reasons. Hansen teaches generating a print job/tickets through a workstation application, which includes printer finishing options (see Fig.1 (102), Fig.4 (302), Col.4, Line 58 – Col.5, Line 17 and Col.11, Line 57-67), wherein the print job/tickets can be associated with a document (see Fig.4 (302,306), Col.12, Line 39-47 and Col.15, Line 37-44). Hansen also teaches that the tickets can be automatically generated (see Col.5, Line 11-17, and the printer finishing options of the tickets can be stored, edited and retrieved for later use (see Fig.1 (118), Fig.4 (302,306), Col.10, Line 17-24, Col.11, Line 57 – Col.12, Line 11 and Col.15, Line 37-44). The desktop application used for creating the print job/tickets could serve as a print driver application, and the printer finishing options of the tickets would be retrieved (intercepted) when they are being saved for later use.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (US Patent 6,407,820 B1) in view of Bhogal et al. (US Patent 7,088,462).
4. Regarding **Claim 1**, Hansen discloses a system for printing electronic files (see Fig. 1 and Col.4, Line 4-13), comprising: a means adapted for receiving an electronic file, wherein the electronic file is representative of a document (see Fig. 1 (102) and Col.4, Line 4-13); a means adapted for receiving a print instruction via an application associated with the electronic file (see Fig.1 (102), Col.4, Line 4-13 and Col.4, Line 51-67); a means adapted for enabling a print driver corresponding to at least one associated document output device in accordance with a received print instruction (see Fig.1 (110,120), Fig.3 and Col.5, Line 45-60); a means adapted for prompting a user, via an application and print driver, for print setting information corresponding to the electronic file, the print setting information including stapling, hole punching, output destination, collating and finishing (see Fig.1 (116,120), Fig.4 (406,408), Col.9, Line 52-60, Col.11, Line 57-67 and Col. 15, Line 37-43); a means adapted for generating printer finishing configuration setting data (see Fig. 1 (106,108), Col.3, Line 66 – Col.4, Line 2 and Col.9, Line 52-60); a means adapted for automatically storing the generated printer configuration setting information data in an associated storage (see Fig.1 (118), Fig.4 (302), Col.6, Line 23-33, Col.8, Line 49-62 and Col.15, Line 37-44); an association means for associatively storing the printer

finishing configuration setting information data with the electronic file such that the subsequent recall of the electronic file automatically retrieves print setting information data associated therewith (see Fig.4 (302), Col.10, Line 17-24 and Col. 12, Line 39- 61); a conversion means for converting the electronic file into an image file (see Fig.4 (320) and Col.5, Line 22-25); a means adapted for creating a print job in accordance with the image file and the printer finishing configuration setting information data (see Fig.4 (320), Col.9, Line 23-39 and Col.9, Line 52-60) a means adapted for receiving data representative of a user request to select the print job for output to at least one selected destination, including a printed copy of the documents and an electronic copy of the image file (see Fig.1 (106, 108,110120), Col.7, Line 25-40 and Col.9, Line 52-60); and a means for retrieving, from the associated storage, the print setting information data corresponding to the electronic file in accordance with a received output request data (see Fig. 1 (106, 108,110120), Col.7, Line 25-40 and Col.9, Line 52-60).

5. Hansen fails to expressly disclose a means for receiving a primary and secondary output request data; and a means for outputting a first copy of the image file in accordance with primary output request data or the second copy of the image file in accordance with secondary output request data. Hansen, however, discloses a means for creating standardized tickets to be stored (Col. 10, Line 17-24); and teaches restoring and updating the stored print tickets for reprinting (see Col.9, Line 52-60 and Col.10, Line 17-24). Bhogal discloses a means for receiving primary and secondary output request data for routing the print jobs to the appropriate printers, based on the received print job information (see Fig.4 (400,408,410), Fig.5 and Col.6, Line 50- 67); a means for retrieving, from the associated storage, the print setting information data corresponding to the electronic file in accordance with a received output request data (see Fig.4

(412,418), Fig.5 and Col.6, Line 50 - Col.7, Line 8); and a means for outputting a first copy of the image file in accordance with primary output request data or the second copy of the image file in accordance with secondary output request data (see Fig.4 (408,410), Fig.5 and Col.6, Line 50 - Col.7, Line 8).

6. Hansen and Bhogal are combinable because they are from the same field of endeavor, namely printing data processing systems. At the time of the invention, it would have been obvious for one skilled in the art to include to Nansen's system, a means receiving a primary and secondary output request data; and a means for outputting a first copy of the image file in accordance with primary output request data or the second copy of the image file in accordance with secondary output request data. The motivation would be to increase the flexibility for the print system in terms of creating customized print settings and default print settings. This would ensure that a print setting is in place when specific print job features are not specified. The modified print system would also enable a user to restore and update existing print settings that were previously stored for reprinting.

7. Regarding **Claim 3**, Hansen further discloses at least one command is in a printer job language format (see Col.4, Line 61 - Col.5, Line 5 and Col.5, Line 47-64).

8. Regarding **Claim 4**, Hansen further discloses the means adapted for creating a print job includes a printer driver (see Col.4, Line 61 - Col.5, Line 5).

9. Regarding **Claim 5**, Hansen further discloses a storage means adapted for storing the print jobs (see Fig.1 (118) and Col.6, Line 23-33).

10. Regarding **Claim 6**, the rationale provided for the rejection of Claim 1 is incorporated herein.

11. Regarding **Claims 7 and 9-11**, the claims recite limitations that are similar and in the same scope of invention as to those in Claims 1 and 3-6 above and or in combination thereof. Therefore, Claims 7 and 9-11 are rejected for the same rejection rationale/basis as described in Claims 1 and 3-6.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625